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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,658	01/23/2001	Jeremy A. Kenyon	41018.P009	3790

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EXAMINER

NGUYEN BA, HOANG VU A

ART UNIT PAPER NUMBER

2192

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/768,658

Applicant(s)

KENYON ET AL

Examiner

Hoang-Vu A Nguyen-Ba

Art Unit

2192

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the Appeal Brief filed on January 24, 2005, PROSECUTION IS HEREBY REOPENED. New grounds of rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. Claims 1-24 are now pending.

Response to Argument

3. Applicant's arguments in the Appeal Brief filed January 24, 2005 have been fully considered and are persuasive. The rejection of claims 1-24 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,742,829 to Moshir et al. al. ("Moshir") is hereby withdrawn. However, claims 1-24 are not yet in condition for allowance and new grounds of rejection are set forth hereinafter.

Claim Rejections – 35 U.S.C. § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in
(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent,
except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

5. Claims 1-24 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0100036 A1 by Moshir et al. ("Moshir").

Claim 1

Moshir discloses at least:

accepting check in by a client computer at a first point in time to determine if the client computer's software needs to be updated (see at least paragraph [0104]); and

providing the client computer with an update task list listing one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software is to be updated (see at least [0055], [0059], [0104], [0195]).

Claim 8

Since claim 8 recites the same limitations of claim 1, the same rejection is therefore applied. Moshir further discloses *performing said one or more tasks asynchronously at a later point or later points in time to update the client computer's software (see at least [0061-0062]).*

Claim 13

Since claim 13 recites an apparatus comprising a storage medium that stores programming instructions executed by a processor to perform the same method steps recited in claim 1, the same rejection is therefore applied.

Claim 20

Since claim 20 recites a client computer comprising a storage medium that stores programming instructions executed by a processor to perform the same method steps recited in claim 1, the same rejection is therefore applied.

Claims 2 and 14

The rejection of base claims 1 and 13, respectively is incorporated. Moshir further discloses *determining if the client computer's software needs to be updated* (see at least section "Discovery Agent," e.g., [0089-0101]).

Claims 3, 9, 15 and 21

The rejection of the base claim is incorporated. Moshir further discloses *re-contacting the server at a later point or later points in times to retrieve one or more software parts* (see at least [0061-0062]).

Claims 4, 10, 16 and 22

The rejection of the base claim is incorporated. Moshir further discloses *re-contacting one or more third part servers at a later point or later points in times to retrieve one or more software parts* (see at least [0058], [0060-0061]).

Claims 5, 11, 17 and 23

The rejection of the base claim is incorporated. Moshir further discloses *one or more installation tasks to be performed asynchronously at a later point or later points in time upon asynchronously obtaining one or more software parts* (see at least [0061-0062]).

Claims 6 and 18

The rejection of the base claim is incorporated. Moshir further discloses *servicing one or more subsequent asynchronous requests from the client computer for software parts in accordance with the tasks listed in the task list* (see at least [0059], [0195-0236]).

Claims 7 and 19

The rejection of the base claim is incorporated. Moshir further discloses *asking the client computer to retry one or more of the subsequent asynchronous requests for software parts* (see at least Figure 3A, item 312 and related discussion in the specification).

Claims 12 and 24

The rejection of the base claim is incorporated. Moshir further discloses *scheduling asynchronous performance of said tasks* (see at least [0061-0062]).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu "Antony" Nguyen-Ba whose telephone number is (571) 272-3701. The Examiner can normally be reached on Tuesday-Friday, 7:15 to 17:45.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tuan Dam can be reached at (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script, reading "Anthony Nguyen-Ba".

**ANTHONY NGUYEN-BA
PRIMARY EXAMINER**

Art Unit 2192
March 28, 2005